

REMARKS

Regarding Groups I and III, the office action alleges that the two sets of claims both drawn to video encoders are distinct and related as combination and subcombination. “A combination is an organization of which a subcombination or element is a part.” This test is not met because both claims are drawing to a video encoder. A subcombination, for example, would be a claim drawn to a part of a video encoder. Thus, there is no showing that invention of claim 1 or claim 29 could be formed from an “organization of which a subcombination or element is a part” of the invention of the other. An engine and drive train is a subcombination of a car, but a car is not a subcombination of a car. In MPEP 806.05(c), combinations are referred to as AB and subcombinations as B.

Also regarding Groups I and III, the common features of claims 1 and 29 and closely related classification demonstrate that joint examination is appropriate and that there is no serious burden on the Examiner. It is noteworthy the each of claims 1 and 29 includes a coder and a plurality of frame buffers (in the case of claim 1 the plurality of frame buffers are the short term and long term reference block buffers). These common features show that issues regarding examination and search will overlap. Also, the Examiner has identified two apparently related subclasses 16 and 17 of class 240. They are assumed to be related as they are consecutive subclasses, though the USPTO web site does not currently indicate the existence of a class 240. Presumably, the Examiner intended to indicate two other closely related subclasses in a single class. Perhaps the Examiner intended to indicate subclasses 216 and 217 of class 348. Subclass 217 is itself considered within the subject matter of the broader subclass 216, which would not show the type of separate classification warranting a restriction. In any event, no divergent classification has been established and a proper search will certainly encompass similar subclasses.

The Examiner has also not demonstrated separate utility for the inventions of Groups I and III. Group III is stated to have “separate utility such as buffer management and control”. This is not a utility for the video encoder, but a feature of the video encoder clearly borrowed from the last phrase of claim 29. The video encoders of both groups have common utility, for example to provide for digital communication and storage of image and video data.

For these separate reasons, Groups III should be examined along with Group I. The Groups are both drawn to video encoders, raises similar issues, require similar search, and present a reasonable number of claims.

Applicant further request that Group II also be examined with Group I for different reasons. First, group II is drawn to a method and Group I for an apparatus that conduct the method. The analysis applied is not the correct test. The correct test is found in MPEP §806.05(e): inventions are distinct if it can be shown that either: “(1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another materially different process.” There has been no attempt to demonstrate that in the restriction requirement, and it should therefore be withdrawn. Also, the method and device are related. The method of claim 28 selectively chooses a high quality long-term frame, and the device of claim 1 includes long term reference block buffer. Thus, the groups raise similar issues, require similar search and present together with Group III a reasonable number of claims.

For all of the above reasons, Applicant requests joint examination. Should the Examiner have any questions or concerns, the Examiner is invited to contact the undersigned attorney at the below listed number.

Respectfully submitted,
GREER, BURNS & CRAIN, LTD.

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300 South Wacker Drive, Suite 2500
Chicago, Illinois 60606
(312) 360-0080
Customer No. 24978

By: /Steven P. Fallon/
Steven P. Fallon
Registration No. 35,132